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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/037,106 | 10/22/2001 | Heinz Wolleb | EL/2-21812/A/CONT/DIV | 5985 |

324 7590 03/28/2003

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| EXAMINER |
|---|
| ANGEBRANNDT, MARTIN J |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1756 | 5 |

DATE MAILED: 03/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/037,106 | WOLLEB ET AL. | |
| | Examiner | Art Unit | |
| | Martin J Angebranndt | 1756 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *22 January 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *2-4 and 8-23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *2-4 and 8-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

1. The response provided by the applicant has been read and given careful consideration. Responses to the arguments and amendments of the applicant are presented after the first rejection to which they are directed. **The application should be amended to indicate the parent application and that it is now a US patent. The examiner notes that the parent application contains a translation of the priority document received on 7/30/2002 and therefore the effective filing date is 11/8/1998.**

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 3 and 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In line 1 of these claims "A A" should read - - A - -.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6 Claims 8,9 and 11 are rejected under 35 U.S.C. 102(b) as being fully anticipated by Cooke et al., J. Chem. Soc., Chem. Commun., pp. 1715-1716 (1995) .

See compound shown in the lower portion of Scheme 1, on page 1715. The octylester linkage uses the carbonyl, oxygen and methylene moieties listed in claim 1. The spectroscopic properties are disclosed including the absorption in the 600-800 nm region in figure 1. a drop fo the compounds is spin coated on a rotating glass slide. The examiner holds that this is inherently able to record information. Figure 2 shows the spectrum of this film.

The applicant did insert a step, but the reference does teach coating it on a substrate, this is not sufficient to obviate the rejection. The coating of the resulting medium with a reflective layer or specifying substrates other than glass slides would overcome the anticipation rejection. The withdrawal of the rejection of claim 2 under this heading, results from reading the claims to preclude the presence of unrecited on the phenyl rings such as the alkyl/octyl moieties the Cook reference.

7 Claims 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cooke et al., J. Chem. Soc., Chem. Commun., pp. 1715-1716 (1995), in view of Kimura et al. EP 0811506 and Itoh et al. '067.

Kimura et al. EP 0811506 teaches the formation of optical recording media in example1, including the measurement of absorption properties. Example 2 includes the reflective layer and protective layer in the structure. The addition of the moieties including the ferrocyanine moieties increases the light resistance of the media. (page 7). The use of these with semiconductor lasers is disclosed.

Itoh et al. '067 teaches that desirable optical recording media using phthalocyanine dyes absorb in the 700-900 nm range and are useful with semiconductor lasers. (2/34-45). The use of

780 nm semiconductor lasers is disclosed at least in examples 1 and 2. The use of these in liquid crystal matrices is also disclosed.

Cooke et al., J. Chem. Soc., Chem. Commun., pp. 1715-1716 (1995) does not disclose optical recording media with structure beyond a simple film coated on a glass slide. It would have been obvious to use the metallocenyl phthalocyanine dye disclosed by Cooke et al., J. Chem. Soc., Chem. Commun., pp. 1715-1716 (1995) in place of the metallocenyl phthalocyanine dye used in the examples of Kimura et al. EP 0811506 with a reasonable expectation of gaining the advantages of improved stability and light resistance disclosed therein and would have been further moved to do so based upon the absorption properties disclosed by Cooke et al., J. Chem. Soc., Chem. Commun., pp. 1715-1716 (1995) which are within the range disclosed as desirable by Itoh et al. '067, who also establishes the linkage between liquid crystal materials and optical recording media.

The applicant argues that the Cook reference does not describe these compounds used in an optical recording medium. The applicant missed the point that the layer containing the compound formed in the glass slide is inherently an optical recording medium within the bounds of the claims. The specification lists glass as an appropriate substrate material on page 18 in the next to last line. The use of spin coating is described in the last paragraph of page 20. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The teaching of Kimura establishes that when using a ferrocenyl-phthalocyanine for optical recording, one should expect

increased resistance to degradation by light,and the teachings of the Itoh reference establishes the analogous nature of optical element such as optical recording media and liquid crystal displays. While the solubility issue raised by the applicant might preclude using the ferrocenyl-phthalocyanine dyes of Kimura with liquid crystals due to solubility issues. The solubility of the dyes of Cook would be expected to be more than soluble for optical recording media applications. Quite simply the applicant's argument is backwards. The issue of the sulfonic acid linkage is irrelevant as the issue is the use of the dye of Cook, unadulterated, in optical recording media, not some bizarre hybrid of the dyes of Cook and Kimura. The rejection stands.

8 The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

**A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).**

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9 Claims 2-4,8,9 and 11-23 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,399,768. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims overlap with those of the issued application as the claims of the patent, particularly claims 4 and 5 embrace coatings of these compounds/mixtures as well as powders, solutions and other states of matter of the compounds. The changes in the

claims do not obviate the rejection, noting that the use of these in optical recording media, holographic recording media, etc., were rejected in the previous office action.

**10** Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

**112 rejections.**

11 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin J Angebranndt whose telephone number is 703-308-4397. The examiner can normally be reached on Mondays-Thursday and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 703-308-2464. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Martin J Angebranndt
Primary Examiner
Art Unit 1756

March 25, 2003